

REMARKS

Claims 17-37 remain in this application. Claims 1, 2, 5, 6, 9, 10, 14, and 15 have been cancelled without prejudice to their subsequent reinstatement. Claims 17-37 have been added. The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

35 U.S.C. §103(a) Rejection – Ano in view of Douglas

The Examiner has rejected claims 1, 2, 5, 6, 9, 10, 14 and 15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2002/0030665 issued to Ano (hereinafter “Ano”) in view of U.S. Patent No. 5,156,049 issued to Douglas (hereinafter “Douglas”).

These claims have been cancelled herein without prejudice to their subsequent reinstatement. Therefore the rejection is believed to be moot.

New Claims Believed To Be Allowable

Claim 17 recites an apparatus comprising “*a keyboard having a space bar and keys; a wheel positioned below the space bar to rotate horizontally relative to a top surface of the keyboard to receive user input, wherein the wheel includes ridges; a tracking device positioned below the space bar to receive user input to direct a cursor displayed on a display, wherein the tracking device is closer to the space bar than the wheel; a right mouse button, wherein the right mouse button is positioned to the right of the wheel; a left mouse button, wherein the left mouse button is positioned to the left of the wheel*”. These limitations are not taught or suggested by any possible combination of Ano and Douglas, which combination does not even seem appropriate. Accordingly, claim 17 is believed to be allowable. Claims 18-19 depend from claim 17 and are

believed to be allowable therefor, as well as for the recitations set forth in each of these claims.

Claim 20 recites an apparatus comprising *"a keyboard having a space bar and keys; a wheel positioned below the space bar to rotate horizontally relative to a top surface of the keyboard; a tracking device; a right button, wherein the right button is positioned to the right of the wheel; a left button, wherein the left button is positioned to the left of the wheel"*. These limitations are not taught or suggested by any possible combination of Ano and Douglas, which combination does not even seem appropriate. Accordingly, claim 20 is believed to be allowable. Claims 21-30 depend from claim 20 and are believed to be allowable therefor, as well as for the recitations set forth in each of these claims.

Claim 31 recites an apparatus comprising *"a keyboard having a space bar and keys; a wheel positioned below the space bar to rotate horizontally relative to a top surface of the keyboard; a tracking device positioned below the space bar, wherein the tracking device is closer to the space bar than the wheel; a right button; and a left button"*. These limitations are not taught or suggested by any possible combination of Ano and Douglas, which combination does not even seem appropriate. Accordingly, claim 31 is believed to be allowable. Claims 32-37 depend from claim 31 and are believed to be allowable therefor, as well as for the recitations set forth in each of these claims.

Ano and Douglas Should Not Be Combined

Applicants further submit that it is simply inappropriate to combine Ano and Douglas as proposed by the Examiner for at least the reasons that: (1) Ano and Douglas are from non-analogous arts; and (2) there is no suggestion or motivation to combine Ano and Douglas.

Firstly, Ano and Douglas are from non-analogous arts. Ano pertains to a coordinate input device, such as a laptop, and portable information apparatus equipped with a coordinate input device (see e.g., the Title). In contrast, Douglas pertains to a manual input system for automotive test equipment (see e.g., the Title). These are non-analogous arts.

As discussed in the MPEP 2141.01(a), to rely on a reference under 35 U.S.C. 103, it must be analogous prior art. *"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned."* In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

The problem addressed in Douglas would not logically have commended itself to an inventor's attention when he/she was considering the problem addressed in Ano. Further an inventor could not possibly be aware of every teaching in every art. In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979).

Secondly, there is no suggestion or motivation to combine Ano and Douglas. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. There is no such suggestion or motivation.

An invention is not obvious where the Examiner fails to provide a suggestion even if the prior art "could" have been combined. The modification is not obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings

of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Accordingly, Ano and Douglas should not be combined.

Conclusion

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Applicants respectfully request that the rejections be withdrawn and the claims be allowed at the earliest possible date.

Request For Telephone Interview

The Examiner is invited to call Brent E. Vecchia at (303) 740-1980 if there remains any issue with allowance of the case.

Request For An Extension Of Time

The Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

Charge Our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,
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